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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,215	02/07/2001	Dirk Ostermann	047763-5014	2043
9629	7590	10/22/2004	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			NOLAND, THOMAS	
			ART UNIT	PAPER NUMBER
			2856	

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/509,215

Applicant(s)

OSTERMANN ET AL.

Examiner

Thomas P. Noland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6, 7 and 9-11 is/are rejected.
- 7) ☒ Claim(s) 8 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant's election of the invention of group 2, claims 6-12 in the reply filed on 12, filed June 3, 2002 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. The lack of unity requirement is made final.
3. Claims 1-5 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12.
4. Applicant is requested to cancel claims 1-5 in any response hereto.
5. The delay in action in this application is regretted. The petition to expunge filed June 3, 2002 was apparently not acted on. However, the petition is considered moot at this time since the material to be expunged has been misplaced from the file and the material desired to be expunged was apparently not scanned in either PACR or E-DAN.
6. Claims 6-12 are objected to because of the following informalities: in claim 7, line 5 after "pin" a comma should be inserted. In claim 6, line 9 "electromagnetic" should be - - - ferromagnetic ---. In claim 12, line 5 "such as plastic or glass" should be deleted. Appropriate correction is required.
7. A new oath or declaration is required because the declaration form signed by inventor Ostermann included interlineations and amendments. The wording

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of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

8. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: The priority PCT application was filed on 25 September 1998 noted 24 September 1998.

9. A supplemental declaration signed by inventor Ostermann with the correct PCT filing date will be sufficient to overcome the above objections.

10. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

11. The abstract from the PCT application would be acceptable if in the last sentence "computer control means" was replaced with - - - computerized controller ---.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

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said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 6-7, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda JP 3-270899 in view of Saito JP 8-23888, both cited in IDS.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda in view of Saito as applied to claim 7 above, and further in view of Delaney et al US 2,712,176.

Maeda in its abstract and drawings shows a cutting device for cutting what could be inherently considered samples but does disclose the use of a solenoid to cause a plunger or pin to eject material collected when cutting. However, such a solenoid driven pin is taught in Saito and would have been obvious to have used in a system similar to that of Maeda to provide a greater force than the compressed air force used in Maeda and thus make dislodging more likely to be complete. Since solenoid driven the plunger/pencil in Saito could be considered to contain ferromagnetic material as claimed. Both Maeda and Saito show the use of what appear to be return springs. In any event such biased elements are a known expedient to have such systems in a ready position. In Maeda the cutting tube and its holding structure substantially blocks off the bore. A more complete closure would be possible with a solenoid driven ejector and would have been an obvious expedient to reduce contamination.

Re claim 10 Maeda also does not show a removable cutting tip but Delaney et al as seen in Figs. 1 and 5 and col. 2, line 70-col. 3, line 8 teaches

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that the cutter in a similar type cutter could be removable. Such would have been obvious expedient to allow adjustment or repair in a system similar to that of Maeda.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references show sample corers or tubular cutters.

15. Shultze et al US 5,998,129, not prior art, US equivalent of W097/29355 cited in IDS. Phillpps US 6,517,561, not prior art, discloses and claims a motorized specimen cutter with a solenoid driven ejector pin but does not claim the use of return means with such.

16. Claims 8 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Noland whose telephone number is (571) 272-2202. The examiner can normally be reached on weekdays from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Hezron E. Williams, can be reached on (571) 272-2208.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Noland/ds
10/13/04

10/21/04
Thomas P. Noland
Primary Examiner
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